

**REMARKS**

Entry of the foregoing, re-examination and reconsideration of the subject matter identified in caption, as amended, pursuant to and consistent with 37 C.F.R. §1.112, and in light of the remarks which follow, are respectfully requested.

New claim 18 describes the water-swelling resin of claim 11 in accordance with the disclosure on page 11, paragraph [0034]. Claim 19 is directed to the features set forth in Figures 2-5. Claims 1-19 are now pending in this application.

The Examiner has repeated and finalized the election of species. For the record, it appears that species (i) and (j) listed on page 4 of the Office Action mailed December 24, 2002, are identical. Applicants believe that claims 11-14, 18 and 19 read on the elected species. Claims 1-10 and 13-17 stand withdrawn from consideration.

Claim 11 was rejected under 35 U.S.C. §102(a) as anticipated by WO 00/37260 to Baker et al for reasons set forth in paragraph (3) of the Office Action. Reconsideration of this rejection is requested for at least the following reasons.

The image-forming element disclosed in Baker et al '260 is not described as recyclable. The top layer is not described as water swellable. There is no disclosure in this document that the cross-linking of the resin in the top layer is such that the layer will swell upon exposure to an aqueous solvent. As discussed by Applicants on page 14, paragraph [0045] of the specification, the conditions of cross-linking (e.g. resin, cross-linking agent, resin molecular weight, proportions of the reactants) must be controlled to provide the layer with the water swelling properties. Excessive cross-linking completely insolubilizes the resin such that water swellability is impossible to attain.

The Examiner's position seems to be based on the theory that the cross-linked top layers in the elements of Baker et al '260 are inherently water swellable. There is no evidence to support this conclusion. "[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." In re Rijckaert, 9 F.3d 1531, 1534, 28 U.S.P.Q.2d 1955, 1957 (Fed. Cir. 1993). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' In re Robertson, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999)." "In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. of Pat. Apps. & Inter. 1990)." Note MPEP §2112.

There is nothing in the disclosure of Baker et al '260 to indicate that the cross-linked top layers of the image-forming elements disclosed therein are water swellable nor that the inventors even desired such a result. The Examiner has not provided "a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art."

For at least the above reasons, the §102(a) rejection over Baker et al '260 should be withdrawn. Such action is respectfully requested.

Claims 11 and 12 were rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 5,362,558 to Sakaki et al in view of U.S. Patent No. 5,985,425 to Tomizawa et al for the reasons given in paragraph (5) of the Office Action. Reconsideration and withdrawal of this rejection are requested for at least the reasons which follow.

The recording medium disclosed in Sasaki et al '558 includes an ink-receptive layer containing inorganic particles dispersed in a water-soluble binder. There is no disclosure or suggestion in this document to insolubilize the water-soluble binder to render it water swellable.

Tomizawa et al '425 discloses an ink-jet recording element which includes an ink-receptive layer containing a water-soluble resin and a cross-linking agent. The cross-linking is designed to improve the water resistance of the recording layer (column 4, lines 32-35). This reference does not disclose that the cross-linked layer is water swellable nor is there any suggestion therein that water swelling of the recording layer would be a desirable feature.

The Office Action includes a statement that the addition of a cross-linking agent in the recording layer of the recording element of Tomizawa et al '425 would result in a water swelling layer. Respectfully, Applicants submit that this is mere conjecture. Cross-linking the water-soluble resin would not inevitably lead to a water swelling layer. As discussed above, one of ordinary skill would need to control the conditions of cross-linking to provide a water swellable property. Applicants refer to the case law on inherency cited above: the Examiner must provide a basis in fact and/or technical reasoning to reasonably

support the conclusion that the inherent result necessarily flows from the prior art disclosure.

Consequently, even if one modifies the recording element of Sasaki et al '558 in accordance with the teachings of Tomizawa et al '425, the resulting recording element would not contain a surface layer comprising a water swellable resin. Neither reference contains any disclosure or suggestion of a recyclable image-recording medium as claimed herein.

For at least the above reasons, the §103(a) rejection should be withdrawn. Such action is respectfully requested.

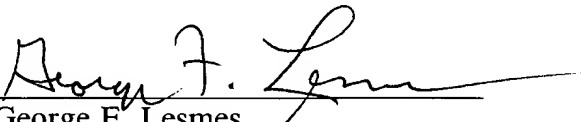
From the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order and such action is earnestly solicited. If there are any questions concerning this paper or the application in general, the Examiner is invited to telephone the undersigned at (703) 838-6683.

Respectfully submitted,

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